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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 5404-04-1
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number 10/711,650	Filed September 29, 2004
	First Named Inventor Calvin Charles Shaw	
	Art Unit 3611	Examiner Silbermann, Joanne

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- applicant/inventor.
- assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- attorney or agent of record. 46,959  
Registration number \_\_\_\_\_.
- attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/Michael R. Nichols/

\_\_\_\_\_  
Signature

Michael R. Nichols

\_\_\_\_\_  
Typed or printed name

972-369-1300

\_\_\_\_\_  
Telephone number

April 7, 2006

\_\_\_\_\_  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

<input type="checkbox"/>	*Total of _____ forms are submitted.
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SFND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

## **I. Final Office Action is incomplete**

The February 2, 2006 Final Office Action fails to consider all of Applicant's claims and is therefore an incomplete action on the merits. In particular, claim 8 recites attaching a magnetic surface to an item associated with the work and magnetically affixing the item to the sheet of material, wherein the item is an envelope. Likewise, claim 18 recites a second detachable attachment surface adapted to be affixed to an item associated with the work, wherein the item is an envelope.

Although the Examiner stated that claims 8 and 18 were rejected under 35 U.S.C. § 103, the Examiner did not cite any teaching or suggestion from the cited references related to a second detachable attachment surface or magnetic surface intended to be attached to an envelope associated with the framed work. Similarly, the Examiner failed to address claims 7, 16, and 17, from which claims 8 and 18 depend. Hence, the Final Office Action does not address the patentability of all of Applicant's claims. The Office bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992).

## **II. No Motivation to Combine References**

In support of her rejection of the independent claims, claims 1 and 11, the Examiner asserts that one skilled in the art would be motivated to combine the full-length slits of *Ristuccia* (used for holding business cards) with the frame and mat of *Anthony* "so as to provide a more secure holding means for the work." (Final Office Action at 2). This is not a proper motivation to combine the references, however, because the *Ristuccia* slits do not, in fact, provide a more secure holding means for the work than do the *Anthony* slits, which are positioned at the four corners of the work being framed. The *Anthony* device holds the work in such a way that it cannot be moved horizontally or vertically. *Ristuccia*'s device, on the other hand, only restrains a business card vertically: if one tries to slide a business card mounted in the *Ristuccia* device from side to side, the card will slide out. Therefore, the motivation to combine these two references proposed by the Examiner simply does not exist.